

U.S. Application No. 10/646,318, filed August 22, 2003
Attorney Docket No. 14366US02
Response AF dated June 2, 2008 to provoke an Advisory Action
In Response to Office Action Made Final mailed April 2, 2008

REMARKS

Claims 56-72 are pending.

Judicially Created Rejection

Claim 56, 60 and 65 stand rejected under the judicially created doctrine of obviousness-type double patenting. Applicants respectfully traverse the rejection as set forth below.

It is alleged, for example, that claim 56 is rejected based on reference claim 105 as set forth in U.S. Patent No. 5,410,141 ("the '141 patent"). Applicants respectfully traverse the rejection as set forth below.

Reference claim 105 the '141 patent depends from claim 104 which, in turn, depends from claim 103 which, in turn, depends from claim 102 which, in turn, depends from claim 101 which, in turn, depends from independent claim 91.

First, the evidence presented by the Examiner refers to claim 94 of the '141 patent. Claim 94 is not part of reference claim 105. Thus, it is inappropriate to include the elements recited in claim 94 of the '141 patent when the reference claim is claim 105 of the '141 patent.

As understood from the Office Action Made Final mailed April 2, 2008, the issue here is whether Applicants are attempting to obtain an extension of the right to exclude. The right to exclude is determined by the *metes and bounds* as delineated in the elements as set forth in reference claim 105, which includes the elements of independent claim 91 and any intervening dependent claims (i.e., claims 101-104); but does not include claim 94 of the '141 patent.

Accordingly, the *prima facie* case with respect to reference claim 105 is lacking with respect to the elements allegedly taught by the elements as set forth in a different reference claim, namely, claim 94 of the '141 patent.

If the Examiner is alleging that claim 56 is rejected based on a different reference claim 94 in the '141 patent which depends from claim 93 which, in turn, depends from claim 92 which, in

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turn, depends from independent claim 91, then the Examiner must present, for the first time, such a *prima facie* case.

Second, claim 56 recites, in part, “at least one antenna ... embedded within the communications module”.

There is no mention in reference claim 105 of the '141 patent or in claims 91 and 101-104, from which claim 105 depends, of “at least one antenna ... embedded within the communications module”.

For at least the above reasons, claim 56 is patentably distinct from reference claim 105 of the '141 patent, which includes the elements as set forth in claims 91 and 101-104 of the '141 patent.

It is therefore respectfully requested that the judicially created rejection be withdrawn with respect to claim 56.

Furthermore, since there is no other substantive rejection of claim 56 as set forth in the Office Action Made Final, claim 56 should be allowed.

It is alleged, for example, that claims 60 and 65 are rejected based on reference claim 105 as set forth in the '141 patent. Applicants respectfully traverse the rejection as set forth below.

Reference claim 105 the '141 patent depends from claim 104 which, in turn, depends from claim 103 which, in turn, depends from claim 102 which, in turn, depends from claim 101 which, in turn, depends from independent claim 91.

First, the evidence presented by the Examiner refers to claim 94 of the '141 patent. Claim 94 is not part of reference claim 105. Thus, it is inappropriate to include the elements recited in claim 94 of the '141 patent when the reference claim is claim 105 of the '141 patent.

As understood from the Office Action Made Final, the issue here is whether Applicants are attempting to obtain an extension of the right to exclude. The right to exclude is determined by the *metes and bounds* as delineated in the elements as set forth in reference claim 105, which includes

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the elements of independent claim 91 and any intervening dependent claims (i.e., claims 101-104); but does not include claim 94 of the '141 patent.

Accordingly, the *prima facie* case with respect to reference claim 105 is lacking with respect to the elements allegedly taught by the elements as set forth in a different reference claim, namely, claim 94 of the '141 patent.

If the Examiner is alleging that claims 60 and 65 are rejected based on a different reference claim 94 in the '141 patent which depends from claim 93 which, in turn, depends from claim 92 which, in turn, depends from independent claim 91, then the Examiner must present, for the first time, such a *prima facie* case.

Second, claims 60 and 65 recites, in part, "at least one antenna ... embedded within the communications module".

There is no mention in reference claim 105 of the '141 patent or in claims 91 and 101-104, from which claim 105 depends, of "at least one antenna ... embedded within the communications module" as set forth in claims 60 and 65.

For at least the above reasons, claims 60 and 65 are patentably distinct from reference claim 105 of the '141 patent, which includes the elements as set forth in claims 91 and 101-104 of the '141 patent.

It is therefore respectfully requested that the judicially created rejection be withdrawn with respect to claims 60 and 65.

It is therefore respectfully requested that the judicially created rejection be withdrawn with respect to claims 56, 60 and 65 and their respective rejected dependent claims (i.e., claims 57-59, 61-64 and 66-72).

Obviousness Rejection under 35 U.S.C. § 103(a)

Claims 59-63 and 69-72 stand rejected under 35 U.S.C. § 103(a) as being obvious over U.S.

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Patent No. 4,857,716 (“Gombrich”) in view of U.S. Patent No. 4,644,366 (“Scholz”) in view of U.S. Patent No. 5,059,951 (“Kaltner”). Applicants respectfully traverse the rejection as set forth below.

Claim 59 depends from claim 56. Since claim 59, via dependence, includes each and every element as set forth in claim 56, Applicants do not understand why dependent claim 59 is rejected as obvious under 35 U.S.C. § 103(a), but claim 56 is not also rejected as being obvious under 35 U.S.C. § 103(a)? How can the independent claim 56 be placed in condition for allowance by filing a terminal disclaimer, but a dependent claim of claim 56 stand rejected under 35 U.S.C. § 103(a)?

Clarification is respectfully requested to place this case in condition for appeal.

Claim 60 recites, in part, “a wireless communications module comprising a transceiver” and “a connector arranged to releasably engage the communications module from the terminal and to transmit signals”.

According to the Office Action, the connector is allegedly the component identified as 120 in FIG. 12 of Gombrich. The wireless communications module comprises a transceiver which is allegedly the RF modem 124. The terminal is allegedly a pen/wand terminal.

However, claim 60 recites, in part, “wherein the terminal ... is arranged to standardize logic levels and a format of the signals transmitted over the connector such that the terminal may be engaged by the communications module through the connector without adjustment of the communications module or the terminal”.

According to the allegations of the Office Action, the pen/wand terminal of Gombrich may be engaged by the wireless communications module (alleged to be the RF modem 124) through the component identified as 120 in FIG. 12 of Gombrich.

However, it is respectfully submitted that Gombrich does not describe that the pen/wand terminal “is arranged to standardize logic levels and a format of the signals transmitted over the

connector such that” the pen/wand terminal of Gombrich may be engaged by the RF modem 124 without adjustment of the RF modem 124 or the pen/wand terminal of Gombrich.

Where does Gombrich teach that the pen/wand terminal is arranged to *standardize logic levels such that* the pen/wand terminal may be engaged by the RF modem 124?

In fact, Gombrich does even not mention “logic levels” at all.

As alleged, since neither Scholz nor Kaltner make up for at least the above teaching deficiencies of Gombrich, it is respectfully submitted that the obviousness rejection cannot be maintained.

It is therefore respectfully requested that the rejection under 35 U.S.C. § 103(a) be withdrawn with respect to claims 60-63.

With regard to the other rejections, Applicants respectfully request that the Examiner reconsider the remarks made in the Amendment filed December 11, 2007, which is incorporated by reference herein for completeness.

Conclusion

Applicants do not necessarily agree or disagree with the Examiner’s characterization of the documents made of record, either alone or in combination, or the Examiner’s characterization of recited claim elements. Furthermore, Applicants respectfully reserve the right to argue the characterization of the documents of record, either alone or in combination, to argue what is allegedly well known, allegedly obvious or allegedly disclosed, or the characterization of the recited claim elements should that need arise in the future.

With respect to the present application, Applicants hereby rescind any disclaimer of

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claim scope made in the parent application or any predecessor or related application. The Examiner is advised that any previous disclaimer of claim scope, if any, and the alleged prior art that it was made to allegedly avoid, may need to be revisited. Nor should a disclaimer of claim scope, if any, in the present application be read back into any predecessor or related application.

In view of at least the foregoing, it is respectfully submitted that the present application is in condition for allowance. Should anything remain in order to place the present application in condition for allowance, the Examiner is kindly invited to contact the undersigned at the below-listed telephone number.

The Commissioner is hereby authorized to charge any additional fees, to charge any fee deficiencies or to credit any overpayments to the deposit account of McAndrews, Held & Malloy, Account No. 13-0017.

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Respectfully submitted,

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